

ESTTA Tracking number: **ESTTA770715**

Filing date: **09/14/2016**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	UMG Recordings, Inc.
Granted to Date of previous extension	09/14/2016
Address	2220 Colorado Avenue Santa Monica, CA 90404 UNITED STATES
Attorney information	BRENT S. LABARGE UNIVERSAL MUSIC GROUP 2220 COLORADO AVENUE SANTA MONICA, CA 90404 UNITED STATES brent.labarge@umusic.com, nicole.villacorta@umusic.com

Applicant Information

Application No	86800107	Publication date	05/17/2016
Opposition Filing Date	09/14/2016	Opposition Period Ends	09/14/2016
Applicant	JHH Entertainment Limited www.jhhentertainment.com Central, 00000 HONG KONG		

Goods/Services Affected by Opposition

Class 014. First Use: 2015/03/10 First Use In Commerce: 2015/09/08
All goods and services in the class are opposed, namely: Jewelry and watches

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act Section 2(d)
Dilution by blurring	Trademark Act Sections 2 and 43(c)
Dilution by tarnishment	Trademark Act Sections 2 and 43(c)

Mark Cited by Opposer as Basis for Opposition

U.S. Registration No.	2881064	Application Date	08/13/2003
Registration Date	09/07/2004	Foreign Priority Date	NONE
Word Mark	JACKSON 5		

Design Mark	JACKSON 5
Description of Mark	NONE
Goods/Services	Class 009. First use: First Use: 1969/04/30 First Use In Commerce: 1969/04/30 MUSICAL SOUND RECORDINGS

Attachments	76536394#TMSN.png(bytes) 2016-09-14 Notice of Opposition -- JHH ENTERTAINMENT.pdf(173491 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Brent S. LaBarge/
Name	BRENT S. LABARGE
Date	09/14/2016

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the matter of Application Serial No. 86800107

UMG RECORDINGS, INC.

Opposer,

v.

JHH ENTERTIANMENT LIMITED,

Applicant.

Opposition No. _____

NOTICE OF OPPOSITION

UMG Recordings, Inc., a Delaware corporation with a business address at 2220 Colorado Avenue, Santa Monica, California 90404, believes that it would be damaged by the issuance of a registration to JHH Entertianment Limited (“Applicant”) for the mark that is the subject of Application Serial No. 86800107 (the “Application”) and hereby opposes registration of the same under the provisions of Section 13 of the Lanham Act, 15 U.S.C. § 1063, and Section 2.101 of the Trademark Rules of Practice, 37 C.F.R. § 2.101.

As grounds therefor, Opposer alleges as follows:

I. OPPOSER’S RIGHTS IN ITS MARKS

1. For decades, UMG Recordings, Inc. and its predecessors-in-interest and licensees (collectively, as applicable, “Opposer”) have continuously used, and Opposer is currently using, the JACKSON 5, JACKSON 5IVE, and J5 trademarks and service marks and the logos depicted below (collectively, “Opposer’s Marks”) in interstate and foreign commerce in connection with a wide variety of goods and services, including, without limitation, music- and entertainment-related goods and services.



2. Opposer's Marks are inherently distinctive and strong and are therefore entitled to a broad scope of protection.

3. As a result of Opposer's extensive, exclusive, and continuous use of Opposer's Marks and substantial promotion of goods and services offered under these marks, and by virtue of the quality of the goods and services offered under these marks, Opposer's Marks have become associated exclusively with Opposer and its goods and services. Consumers have come to rely on Opposer's Marks to identify Opposer's goods and services and to distinguish them from the goods and services of its competitors. As such, Opposer's Marks have developed extensive goodwill and consumer recognition and have become famous and well-known in the United States and throughout the world.

4. Opposer's Marks are the subject of the following U.S. trademark registration owned by Opposer: U.S. Registration No. 2881064 for the mark JACKSON 5 in connection with "musical sound recordings" in International Class 9. A true and correct copy of a printout from the U.S. Patent and Trademark Office's online Trademark Status and Document Retrieval

(TSDR) database showing the current status and title of this registration is attached hereto as Exhibit 1.

5. The foregoing registration is valid, subsisting, and in full force and effect. This registration constitutes evidence of the validity of the registered mark and of the registration thereof, of Opposer's ownership of the registered mark, and of Opposer's exclusive right to use the registered mark in commerce in connection with the identified goods pursuant to Section 7(b) of the Lanham Act, 15 U.S.C. § 1057(b). Such registration places others on constructive notice of Opposer's claim of ownership thereof pursuant to Section 22 of the Lanham Act, 15 U.S.C. § 1072.

6. The foregoing registration is incontestable pursuant to Section 15 of the Lanham Act, 15 U.S.C. § 1065, and thus serves as *conclusive* evidence of Opposer's exclusive right to use the registered mark in connection with the goods identified in the registration pursuant to Section 33(b) of the Lanham Act, 15 U.S.C. § 1115(b).

7. Opposer also owns common law rights in Opposer's Marks based on its extensive use and promotion of such marks in interstate and foreign commerce for many years.

II. APPLICANT'S APPLICATION TO REGISTER THE CONTESTED MARK

8. On October 27, 2015, Applicant filed the Application under Section 1(a) of the Lanham Act for the J50th & Design mark (the "Contested Mark") for "jewelry and watches" in International Class 14. At the time of filing, Applicant identified March 10, 2015, as the date on which the Contested Mark was allegedly first used anywhere, and September 8, 2015, as the date on which the Contested Mark was allegedly first used in interstate commerce in connection with the goods listed in the foregoing application.

9. The Application was published for opposition on May 17, 2016; Opposer's time to oppose the Application has since been extended to September 14, 2016.

10. Opposer acquired rights in Opposer's Marks long before Applicant filed the Application, long before any commercial use by Applicant of the Contested Mark, and long before any priority date upon which Applicant may rely.

III. LIKELIHOOD OF CONFUSION

11. The Contested Mark, as used in association with the goods recited in the Application, is so similar to Opposer's Marks as to be likely to create confusion, mistake, or deception as to the source, sponsorship, or affiliation of Applicant's services in the minds of consumers and persons in the trade for the following reasons, among others:

12. The Contested Mark is virtually identical in sight, sound, and commercial meaning to each of Opposer's Marks. Indeed, the dominant J5 design component of the Contested Mark is identical in all respects to the J5 design incorporated in Opposer's logos shown in Paragraph 1.

13. The goods recited in the Application are identical and/or closely related to the goods and services offered by Opposer in connection with Opposer's Marks.

14. On information and belief, Applicant's goods offered in connection with the Contested Mark, if any, and the goods and services offered under Opposer's Marks are likely to be sold, marketed, and/or offered to the same classes of consumers.

15. On information and belief, the channels of trade for Applicant's goods offered in connection with the Contested Mark, if any, and the channels of trade for Opposer's goods and services offered under Opposer's Marks are the same.

16. Applicant's use and/or registration of the Contested Mark for the goods listed in the Application is thus likely to cause confusion or mistake, or to deceive the public, in violation of Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d).

IV. DILUTION

17. Opposer's Marks are distinctive and have been used by Opposer for many years (and still are being used by Opposer) in connection with a wide variety of goods and services.

18. Opposer's Marks are famous.

19. Opposer's Marks became famous long before Applicant filed the Application, long before any commercial use by Applicant of the Contested Mark, and long before any priority date upon which Applicant may rely.

20. Applicant's use and/or registration of the Contested Mark for the services listed in the Application is thus likely to dilute Opposer's Marks in violation of Section 43(c) of the Lanham Act, 15 U.S.C. § 1125(c).

V. INJURY TO OPPOSER

21. Permitting Applicant to register the Contested Mark in connection with the goods recited in the Application would be inconsistent with Opposer's prior exclusive rights in Opposer's Marks and would threaten to destroy Opposer's investment and goodwill in such marks. Opposer thus would be injured by the registration of the Application.

22. Permitting Applicant to register the Contested Mark in connection with the goods recited in the Application further damages Opposer, since registration would confer upon Applicant various statutory presumptions to which it is not entitled given Opposer's longstanding prior use of Opposer's Marks.

23. Permitting Applicant to register the Contested Mark in connection with the goods recited in the Application would weaken the strength and reputation of Opposer's Marks, resulting in damage and injury to Opposer.

WHEREFORE, Opposer respectfully requests that this opposition be sustained and that the Application be denied registration. This Notice of Opposition is submitted electronically and the undersigned hereby authorizes the payment of all official filing fees or any other fees due from Deposit Account No. 50-4955.

Dated: September 14, 2016

Respectfully submitted,

UMG RECORDINGS, INC.

By: s/Brent S. LaBarge/
Brent S. LaBarge
c/o Universal Music Group
2220 Colorado Avenue
Santa Monica, California 90404
Telephone: (310) 865-1708
Email: brent.labarge@umusic.com;

Attorneys for UMG Recordings, Inc.

EXHIBIT 1

1. The Post Registration "Maintenance Tab" has been temporarily disabled. It will return soon.
2. TSDR now displays information regarding [TM5 Common Status Descriptors](#).

STATUS **DOCUMENTS**[Back to Search](#)

Print

Generated on: This page was generated by TSDR on 2016-09-14 17:32:13 EDT**Mark:** JACKSON 5**JACKSON 5****US Serial Number:** 76536394**Application Filing Date:** Aug. 13, 2003**US Registration Number:** 2881064**Registration Date:** Sep. 07, 2004**Register:** Principal**Mark Type:** Trademark**TM5 Common Status
Descriptor:**

LIVE/REGISTRATION/Issued and Active

The trademark application has been registered with the Office.

Status: The registration has been renewed.**Status Date:** Sep. 08, 2014**Publication Date:** Jun. 15, 2004**Mark Information****Mark Literal Elements:** JACKSON 5**Standard Character Claim:** No**Mark Drawing Type:** 1 - TYPESET WORD(S) /LETTER(S) /NUMBER(S)**Disclaimer:** "5"**Related Properties Information****Claimed Ownership of US** [0965809](#)

Registrations:**Goods and Services****Note:**

The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis ((...)) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
- Asterisks *..* identify additional (new) wording in the goods/services.

For: MUSICAL SOUND RECORDINGS

International Class(es): 009 - Primary Class

U.S Class(es): 021, 023, 026, 036, 038

Class Status: ACTIVE

Basis: 1(a)

First Use: Apr. 30, 1969

Use in Commerce: Apr. 30, 1969

Basis Information (Case Level)

Filed Use: Yes	Currently Use: Yes	Amended Use: No
Filed ITU: No	Currently ITU: No	Amended ITU: No
Filed 44D: No	Currently 44D: No	Amended 44D: No
Filed 44E: No	Currently 44E: No	Amended 44E: No
Filed 66A: No	Currently 66A: No	
Filed No Basis: No	Currently No Basis: No	

Current Owner(s) Information

Owner Name: UMG RECORDINGS, INC.

Owner Address: 2220 Colorado Avenue
Santa Monica, CALIFORNIA UNITED STATES 90404

Legal Entity Type: CORPORATION

**State or Country Where
Organized:** DELAWARE

Attorney/Correspondence Information

Attorney of Record**Attorney Name:** Brent LaBarge**Attorney Primary Email** brent.labarge@umusic.com**Attorney Email Authorized:** Yes**Address:****Correspondent****Correspondent** Brent LaBarge**Name/Address:** Universal Music Group

2220 Colorado Avenue

Santa Monica, CALIFORNIA UNITED STATES 90404

Phone: 310-865-1708**Fax:** 310-865-1791**Correspondent e-mail:** brent.labarge@umusic.com**Correspondent e-mail** Yesnicole.villacorta@umusic.com**Authorized:****Domestic Representative - Not Found****Prosecution History**

Date	Description	Proceeding Number
Sep. 08, 2014	NOTICE OF ACCEPTANCE OF SEC. 8 & 9 - E-MAILED	
Sep. 08, 2014	REGISTERED AND RENEWED (FIRST RENEWAL - 10 YRS)	68502
Sep. 08, 2014	REGISTERED - SEC. 8 (10-YR) ACCEPTED/SEC. 9 GRANTED	68502
Sep. 08, 2014	CASE ASSIGNED TO POST REGISTRATION PARALEGAL	68502
Aug. 25, 2014	TEAS SECTION 8 & 9 RECEIVED	
Jun. 10, 2011	COUNTERCLAIM CANC. NO. 999999	53622
Sep. 08, 2010	REGISTERED - SEC. 8 (6-YR) ACCEPTED & SEC. 15 ACK.	70619
Sep. 07, 2010	CASE ASSIGNED TO POST REGISTRATION PARALEGAL	70619
Aug. 18, 2010	TEAS SECTION 8 & 15 RECEIVED	
Sep. 07, 2004	REGISTERED-PRINCIPAL REGISTER	
Jun. 15, 2004	PUBLISHED FOR OPPOSITION	
May 26, 2004	NOTICE OF PUBLICATION	
Apr. 02, 2004	APPROVED FOR PUB - PRINCIPAL REGISTER	
Mar. 02, 2004	EXAMINER'S AMENDMENT MAILED	

Feb. 21, 2004

ASSIGNED TO EXAMINER

72152

Maintenance Filings or Post Registration Information**Affidavit of Continued Use:** Section 8 - Accepted**Affidavit of Incontestability:** Section 15 - Accepted**Renewal Date:** Sep. 07, 2014**TM Staff and Location Information****TM Staff Information - None****File Location****Current Location:** GENERIC WEB UPDATE**Date in Location:** Sep. 08, 2014**Assignment Abstract Of Title Information - None recorded****Proceedings**

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing Notice of Opposition has been served by mailing said copy on September 14, 2016, via First Class Mail, postage prepaid, to:

JHH ENTERTIANMENT LIMITED
RM 403 4/F SBI CTR 54-56 DES VOEUX RD
CENTRAL, 00000
HONG KONG

s/Brent S. LaBarge/

Brent S. LaBarge